

Appl. No.: 10/540,812
Reply to Office Action of: 01/08/2008

REMARKS

Claims 1, 3, 5-7, 9-11, and 13 were rejected under 35 U.S.C. §102(b) as being anticipated by Kunishi et al. (US 5,306,168). Claims 4, 8, and 12 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kunishi in view of Yokoyama et al. (US 6,347,950). The examiner is requested to reconsider these rejections.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). It is submitted that Kunishi fails to teach each and every element as set forth in claims 1, 6, and 10 for at least the reasons described below.

Claim 1 has been amended to recite, *inter alia*, "wherein the connector comprises a gap between the second stoppers and the fixing portion to allow movement therebetween". In contrast, Kunishi merely discloses a floating type electrical connector having a housing 4 comprising an inner movable housing portion 9 connected to an outer stationary housing portion 10 by resilient joint pieces 11, and a plurality of female terminals 5 disposed within the housing 4. The female terminals 5 comprise a base section 19 having laterally extending arms 31, 32, with projections 24 extending from the laterally extending arms 31, 32. The examiner asserted that the base arm 31 anticipates the feature "second stoppers". However, in Kunishi, "the opposite base arms 31 and 32 are fitted in the opposite recesses 33 and 34 of the stationary housing 10, and

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at the same time, the opposite projections 24 of the base section 19 are fitted in the opposite longitudinal holes 35" (see col. 4, lines 35 - 39, and Fig. 6). The projections 24 which extend from the laterally extending arms 31, 32 "skive into the stationary housing portion 10 at holes 35" (see col. 4, lines 1-2 and Fig. 6). As such, since the projections 24 are embedded and locked to the stationary housing portion 10, the base arms 31, 32 are not movable relative to the stationary housing portion 10. Therefore, as the base arms 31, 32 are not movable relative to the stationary housing portion 10, there is no gap between the base arms 31, 32 and the stationary housing portion 10 to allow movement therebetween.

Additionally, Kunishi discloses a floating connector which can only limit excess movement of the movable housing 20 towards the stationary housing 10. This is enabled by "permitting the bottom 27 of the moveable housing section 9 to abut against the rest sections 26" (col. 5, lines 28 - 30 of Kunishi). Kunishi does not disclose a connector having any movement limit structure or function, when the movable housing moves away from the stationary housing, as the case of claimed invention. Thus, Kunishi fails to teach or disclose "wherein the second stoppers come into contact with the fixing portion when the fixing portion is moved in a direction away from the opposing connector thereby stopping said protruding portion when the connector is removed from the opposing connector", as claimed in claim 1.

The examiner stated that "it has been held that a recitation with respect to the manner in which a claimed apparatus is

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intended to be employed (i.e. movable) does not differentiate the claimed apparatus from the prior art by satisfying the claimed structural limitations". Applicant submits that the recitation of "wherein the contact portions are movable ..." provides a function limitation. The examiner is directed to MPEP §2173.05(g). A function limitation is an attempt to define something by what it does, rather than by what it is. There is nothing inherently wrong with defining some part of an invention in functional terms. A functional limitation must be evaluated and considered, just like any other limitation of the claim.

There is no teaching in Kunishi that the laterally extending arms 31, 32 (or any other disclosed features) are movable relative to the housing portion 10 and come into contact with the housing portion 10 thereby stopping the movable portion of the housing 4 when the connector is removed from the opposing connector, let alone a gap between the extending arms 31, 32 and the housing portion 10 to allow movement therebetween, as claimed in amended claim 1. Accordingly, claim 1 is patentable over the art of record and should be allowed.

Though dependent claims 3-5 contain their own allowable subject matter, these claims should at least be allowable due to their dependence from allowable claim 1. However, to expedite prosecution at this time, no further comment will be made.

Claim 6 claims "wherein said contact portions comprise second stoppers adapted to move toward the fixing portion and come into contact with the fixing portion when the fixing portion

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is moved in a direction away from the opposing connector thereby stopping said protruding portion when the connector is removed from the opposing connector". Similar to the arguments above with respect to claim 1, the opposite base arms 31 and 32 in Kunishi are fitted in the opposite recesses 33 and 34 of the stationary housing 10 (with the projections 24 embedded and locked to the stationary housing portion 10). Therefore, the base arms 31 and 32 are not adapted to move toward the stationary housing portion 10 when the connector is removed from the opposing connector.

The examiner cited In re Hutchison 69 USPQ 138 as holding that "the recitation that an element is "adapted for" perform a function is not a positive limitation but only requires the ability to so perform ... [i]t does not constitute a limitation in any patentable sense". Applicant respectfully submits that the examiner's statements are incorrect.

In re Hutchison holds that the term "adapted to" used in the preamble is not given patentable weight. However, In re Venezia 189 USPQ 149 (CCPA 1976) explicitly held that the phrase "a pair of sleeves *** each sleeve of said pair adapted to be fitted over the insulating jacket of one of said cables" imparts a structural limitation to the sleeve. The court went on to hold that the language "adapted to be affixed" and "adapted to be positioned" also defines present structures or attributes of the part which limits the structure of the housing. Thus, it appears that In re Hutchison only applies to the preamble of a claim, not the body of a claim.

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The examiner is also directed to MPEP §2173.05(g) which states:

"In a claim that was directed to a kit of component parts capable of being assembled, the Court held that limitations such as "members adapted to be positioned" and "portions . . . being resiliently dilatable whereby said housing may be slidably positioned" **serve to precisely define present structural attributes of interrelated component parts of the claimed assembly.** *In re Venezia, 530 F.2d 956, 189 USPQ 149 (CCPA 1976).*" (emphasis added)

Accordingly, the functional limitations recited in claim 6 must be considered and evaluated. Claim 6 is patentable over the art of record and should be allowed.

Though dependent claims 7-9 contain their own allowable subject matter, these claims should at least be allowable due to their dependence from allowable claim 6. However, to expedite prosecution at this time, no further comment will be made.

Claim 10 has been amended to recite, *inter alia*, "wherein the second stoppers are spaced from sections of the fixing portion when the connector is inserted in the opposing connector, and wherein the second stoppers are adapted to contact the sections of the fixing portion when the fixing portion is moved in a direction away from the opposing connector when the connector is removed from the opposing connector". Similar to the arguments above with respect to claim 1, the opposite base arms 31 and 32 in

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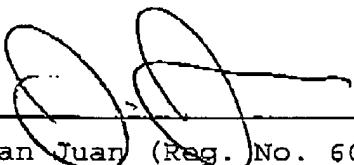
Kunishi are fitted in the opposite recesses 33 and 34 of the stationary housing 10 (with the projections 24 embedded and locked to the stationary housing portion 10). Therefore, the base arms 31 and 32 are not spaced from sections the stationary housing portion 10 during 'insertion' of the connector and adapted to contact the sections of the stationary housing portion 10 during 'removal' of the connector.

Though dependent claims 11-13 contain their own allowable subject matter, these claims should at least be allowable due to their dependence from allowable claim 10. However, to expedite prosecution at this time, no further comment will be made.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record. Accordingly, favorable reconsideration and allowance is respectfully requested. If there are any additional charges with respect to this Amendment or otherwise, please charge deposit account 50-1924 for any fee deficiency. Should any unresolved issue remain, the examiner is invited to call applicant's attorney at the telephone number indicated below.

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Respectfully submitted,


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